

## REMARKS

Entry of the foregoing amendment is respectfully requested. The Amendment is believed to place the application in condition for allowances and is, therefore, appropriate under Rule 116. The Amendment does not raise any new issues and, thus, does not require an additional search by the Examiner. The issues raised by the amended claim 1 are the same issues raised by the presently pending claims 1, 4, and 6.

The Amendment was not earlier presented because applicant became familiar with new grounds for rejection only after they were first set forth in the final Office Action.

By the present amendment, claims 4 and 6 are canceled, and claim 1 is amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

The Examiner rejected claims 1-5 under 35 U.S.C. § 102(a) as being anticipated by Patton et al., U.S. Patent Publication US 2002/0158102 (Patton). Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Patton

in view of Hirai et al., U.S. Patent No. 6,220,496 (Hirai). Claims 1-3 were further rejected under 35 U.S.C. § 103(a) as being unpatentable over Obergfell, U.S. Patent No. 3,850,359 (Obergfell) in view of Patton, over Ohtsu, U.S. Patent No. 4,773,581 (Ohtsu) in view of Patton, and over Adams, U.S. Patent No. 4,665,868 (Adams). Claims 4-6 were further rejected under 35 U.S.C. § 103(a) as being unpatentable over Obergfell, Ohtsu, or Adams in view of Patton and further in view of Hirai.

It is respectfully submitted that claims 1-3 and 5, claims 4 and 6 having been cancelled, are patentable over the cited references. Specifically, claim 1 recites (i) a combustion chamber (11) located in the housing (10), (ii) a storage reservoir (22) for at least one of oxidation medium and fuel; (iii) a pressure conduit (27) extending between the storage reservoir (22) and the combustion chamber (11); and (iv) a control valve (28) provided in the pressure conduit (27) that extends between the storage reservoir (22) and the combustion chamber (11) for controlling pressure of the oxidation medium-fuel mixture in the combustion chamber. It is respectfully submitted that the foregoing novel features of the present invention are not disclosed or suggested in the prior art, including all of the prior art of record in this application, whether taken alone or in combination. Considering the prior art, Patton does not disclose or suggests use of a combustion chamber for combusting fuel in order to generate expanding gases acting on a drive piston. In Patton, the

compressed air is communicated directly to the pneumatic cylinder for driving the tool.

It is noted that the Office Action asserts that a combustion chamber is provided in the head (11) of the pneumatic tool of Patton. Applicant carefully reviewed the reference and could not find any mentioning of a combustion chamber located in the tool head or elsewhere. If the rejection over Patton in view of Hirai is maintained, applicant respectfully requests that the Office Action indicates where the reference to a combustion chamber (combustion) is mentioned in Patton.

Hirai likewise does not disclose a combustion driven setting tool. Hirai discloses a pneumatically operated nail machine (column 1, lines 50-61). Not disclosing a combustion chamber, Hirai does not disclose and cannot disclose a conduit connecting the storage reservoir with the combustion chamber, and a valve arranged in the conduit for controlling air flow therethrough to thereby control the pressure of the air-fuel mixture in the combustion chamber.

Because the combination of Patton and Hirai lacks several important and recited features of claim 1, the present invention, as defined by claim 1, is patentable over the combination of Patton and Hirai.

It is further respectfully submitted that the present invention, as defined by claim 1, would not be made obvious by any of combination Obergfell, Patton and Hirai; Ohtsu, Patton and Hirai, and Adams. Patton and Hirai for reasons discussed above. Specifically, Hirai does not disclose a control valve for controlling air flow in order to control the pressure of an air-fuel mixture. Hirai discloses a pressure-reducing valve used to bring the accumulator pressure to the working pressure.

It is generally submitted that a *prima facie* case of obviousness has not been made.

Under MPEP §2143, a *prima facie* case of obviousness requires that three basic criteria be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that none of the elements of *prima facie* obviousness has been established.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination.” Under Section 103, teachings of references can be

combined only if there is some suggesting or incentive to do so” *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783 (Fed.Cir. 1992) (footnote omitted) (emphasis in original). See also *In re Sernaker*, 217 U.S.P.Q. 1, 6 (Fed.Cir. 1983); *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q. 2d 1397, 1399 (Fed.Cir. 1989); *In re Fine*, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP §2143.01 relying on *Ex Parte Levensgood*, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” *Id.* at 1301. It is noted that the Federal Circuit requires that the determination of obviousness be based on a concrete evidence and rejects the “common knowledge” of one skilled in the art as a substitute for specific evidence . . . . *In re Lee*, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002)

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrive at the claimed invention. *In re Jones*, 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

*Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Circuit clearly stated: It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992).

The *In re Fritch* holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements,” that the prior art must be viewed “without reading into that art Appellant’s teachings,” and that teachings of the prior art should “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the

original text) make the invention as a whole obvious.” *In re Sponnoble*, 160

U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art do not make the present application obvious.

It is respectfully submitted that obviousness of the present invention over the combinations set forth in the Office Action, can be gleaned from only a hindsight reconstruction. The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in *Uniroyal v. Redkin-Willey*, 5 U.S.P.Q. 2d 1434, 1438 (Fed.Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

\* \* \*

. . . it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

In *Orthopedic Equipment Company, Inc. v. United States*, 217 U.S.P.Q. 193-199 (Fed. Cir. 1983), the Federal Circuit warned:

The difficulty which attaches to all honest attempts to answer this question [of obviousness based upon a combination of prior art] can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law.

In view of the above, it is respectfully submitted that the combinations the Office Action relies on, do not make obvious the present invention, as defined in Claim 1, and the present invention is patentable over said combinations.

Claims 2-3 and 5 depend on Claim 1 and are allowable for the same reasons Claim 1 is allowable, and further because of specific features recited therein which, when taken alone or in combination with features recited in Claim 1, are not disclosed or suggested in the prior art.

## **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested



that such amendment or correction be carried out by Examiner's Amendment and the case passed issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

Alexander Zinchuk

Alexander Zinchuk  
Reg. No. 30,541

Date: June 30, 2005  
Sidley Austin Brown & Wood LLP  
787 Seventh Avenue  
New York, NY 10019  
Tel.: (212) 839-7365

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Alexander Zinchuk

Alexander Zinchuk